REMARKS

Claims 1-25 are pending in the present application.

Claims 1, 11, and 21 have been rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.

Claims 1, 11, and 21 have been rejected under 35 U.S.C. §112 ¶2 as being indefinite.

Claims 1-25 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,189,146 to Misra, *et al.* ("Misra") in view of U.S. Patent No. 7,343,297 to Bergler, *et al.* ("Bergler").

Claims 1-25 have been amended within the subject matter of the application as filed. It is respectfully submitted that no new matter has been added.

Reconsideration of the application as amended herein is respectfully requested.

CLAIM REJECTIONS

Rejections under 35 U.S.C. §101 & 35 U.S.C. §112

Claims 1, 11, and 21 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Claims 1, 11, and 21 are also rejected under 35 U.S.C. §112 as being indefinite for failing to particularly point out and distinctly claim the invention. Regarding the rejection of Claims 1, 11, and 21, the Examiner states:

> Claims 1, 11, and 21 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite...Claims 1, 11, and 21 are indefinite because the claims are considered hybrid claims. See MPEP §2173.05(p) II. In particular, the claim is directed to neither a "process" nor a "machine" but rather embrace or overlap two different statutory classes of invention as set forth in 35 U.S.C. §101.

07/21/09 Office Action, pp. 2-3.

In response, Claim 1 is amended herein to recite "A system, comprising...," Claim 11 is amended herein to recite "A system, comprising...," and Claim 21 is amended herein to recite "A computer readable medium..." Therefore, applicants respectfully submit the Examiner's rejections of Claims 1, 11, and 21 under 35 U.S.C. §101 and §112 are overcome.

Rejections under 35 U.S.C. §103(a)

Claims 1-25 are rejected under 35 U.S.C. §103(a) as being unpatentable over Misra in view of Bergler. Applicants respectfully disagree and submit that Claims 1-25 are patentable under 35 U.S.C. §103(a) over Misra in view of Bergler. Regarding the rejection of Claim 1, the Examiner stated:

> Misra does not explicitly disclose licenses being returned by the computer to the server. However, Bergler teaches licenses being returned (Abstract, "automatically returned to the license server's available pool", ¶[0025]) to the license pool as part of license management by the server to assure the license availability to other computers in the network.

07/21/2009 Office Action, pp. 5-6. Applicants respectfully disagree for the following reasons.

> Claim 1 is amended to recite:
>
> first subset of the plurality of license rights is available under the license to a first computer...second subset of license rights is available under the license to a second computer...first subset of the plurality of license rights, and the second subset of the plurality of license rights are voluntarily returnable by the first and second computers to the server

Claim 1, emphasis added. As acknowledged by the Examiner, Misra does not teach or suggest the feature of licenses being returned by a computer to a server, therefore Misra does not teach the feature of "first subset of the plurality of license rights, and the second subset of the plurality of license rights are voluntarily returnable by the first and second computers to the server."

07/21/09 Office Action, pp.5-6. Bergler does not provide such a teaching either. Bergler describes that any license previously issued to a client that has been returned by the license clean-up module is subject to being given to a different client. Bergler, col. 12, lines 14-17. Bergler's license includes a list of features to be enabled. Bergler, col. 10, lines 55-56. In other words, Bergler describes issuing a license having a list of enabled features to a client, and the client returning the license. Bergler does not disclose:

> first subset of the plurality of license rights is available under the license to a first computer...second subset of license rights is available under the license to a second computer...first subset of the plurality of license rights, and the second subset of the plurality of license rights are voluntarily returnable by the first and second computers to the server,

as recited in Claim 1. Because neither Misra nor Bergler, alone or in combination, teach or suggest such a feature, applicants respectfully submit that Claim 1, and Claims 2-10 that depend from Claim 1, are patentable under 35 U.S.C. §103(a) over Misra in view of Bergler.

Claim 11 is rejected for the same reasons as Claim 1 above. Claim 11 discloses substantially similar limitations as Claim 1, including:

> first subset of the plurality of license rights is available under the license to a first computer...second subset of license rights is available under the license to a second computer...first subset of the plurality of license rights, and the second subset of the plurality of license rights are voluntarily returnable by the first and second computers to the server

Claim 11, emphasis added. As discussed above with regard to the rejection of Claim 1, neither Misra nor Bergler provide such a teaching. Because neither Misra nor Bergler, alone or in combination, teach or suggest such a feature, applicants respectfully submit that Claim 11, and Claims 12-20 that depend from Claim 11, are patentable under 35 U.S.C. §103(a) over Misra in view of Bergler.

Claim 21 is rejected for the same reasons as Claim 1 above. Claim 21 discloses substantially similar limitations as Claim 1, including that

> first subset of the plurality of license rights is available under the license to a first computer...second subset of license rights is available under the license to a second computer...first subset of the plurality of license rights, and the second subset of the plurality of license rights are voluntarily returnable by the first and second computers to the server

Claim 21, emphasis added. As discussed above with regard to the rejection of Claim 1, neither Misra nor Bergler provide such a teaching. Because neither Misra nor Bergler, alone or in combination, teach or suggest such a feature, applicants respectfully submit that Claim 21, and Claim 22 that depends from Claim 21, are patentable under 35 U.S.C. §103(a) over Misra in view of Bergler.

Claim 23 is rejected for the same reasons as Claim 1 above. Claim 23 discloses substantially similar limitations as Claim 1, including that

> first subset of the plurality of license rights is available under the license to a first computer...second subset of license rights is available under the license to a second computer...first subset of the plurality of license rights, and the second subset of the plurality of license rights are voluntarily returnable by the first and second computers to the server

Claim 23, emphasis added. As discussed above with regard to the rejection of Claim 1, neither Misra nor Bergler provide such a teaching. Because neither Misra nor Bergler, alone or in combination, teach or suggest such a feature, applicants respectfully submit that Claim 21, and Claims 24-25 that depend from Claim 23, are patentable under 35 U.S.C. §103(a) over Misra in view of Bergler.

CONCLUSION

In view of the foregoing, it is believed that all claims now pending (1) are in proper form, (2) are neither obvious nor anticipated by the relied upon art of record, and (3) are in condition for allowance. A Notice of Allowance is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (650) 614-7400. If there are any additional charges, please charge Deposit Account No. 15-0665.

Respectfully submitted,
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